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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,943	12/27/2000	Gregory C. Flickinger	T721-17	6477

27832 7590 10/29/2003

EXPANSE NETWORKS, INC.
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EXAMINER	
BUI, KIEU OANH T	

ART UNIT	PAPER NUMBER
2611	10

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/748,943	FLICKINGER ET AL.	
	Examiner	Art Unit	
	KIEU-OANH T BUI	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Remark

1. Claims 1-16 were canceled without prejudice (paper no. 7). New claims 17-36 are added. Pending claims are claims 17-36.

Response to Amendment

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive, due to the reason that the Hendricks et al (US 2002/0104083) filed in 10/2001 (although which is a CIP of earlier applications and patents), which is a later date than this claiming priority date of 08/31/2000 and, therefore, the finality of that action is withdrawn.

Response to Arguments

3. Applicant's arguments with respect to new claims 17-36 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless --*
> *(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the* invention by the applicant for *patent or (2) a patent granted on an application for patent* by another filed in the United *States before the invention by the applicant for patent,* except that an international *application filed under the treaty defined in section 351*(a) shall have the effects for *purposes of this subsection of an application filed in* the United States only if the *international application designated the United States* and was published under Article *21(2) of such treaty in the English language.*

5. Claims 17-22, 27-29, 32-33, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al. (U.S. Patent 6,463,585/or "Hendricks" hereinafter).

Regarding claims 17, 27 and 32-33, Hendricks discloses "in a television network environment" (Fig. 1) consisting of "a display device" (Fig. 3/item 222) "and a storage medium" (Fig. 4, item 267), a method for "delivering targeted advertisements to subscribers in advance of presentation of the advertisements to the subscribers", i.e., a plurality of set top terminals 220 receives advertisements from a headend system 208 under a network controller 214 (Fig. 1, and col. 8/line 62 to col. 9/line 58) and stores the ads before presentation to subscribers (Fig. 34 for an ads storage), the method comprising: "transmitting advertisements to subscribers over an advertisement channel", for instance, a 6 MHZ digital channel as the ad channel and that channel can either carry analog or digital signals (col. 9/line 65 to col. 10/line 26 for analog and digital services are included; and Fig. 32 for commercial channels on available bandwidths, and col. 73/lines 13-55 for advertisement channels addressed), "wherein the advertisements are transmitted at a bandwidth that is less then the bandwidth required to present the advertisement in real time, and are accordingly transmitted in advance of presentation of the advertisements to the subscribers; and storing the advertisements in a storage medium", i.e., advertisements not in real-time requires less bandwidth and not requiring additional feeder channel to continuously broadcasting targeted advertisements and advertisements can be stored locally in the set top box or memory medium 33 of set top terminal 220 or in an alternate view in Figure 34 with "Storage of Ads" at the set top terminal before retrieving for displaying to subscribers at a later time (Figs. 33-34, and col. 74/lines 4-16 for the Storage method).

As for claims 18-22, 28-29 and 36, in view of claim 17 above, Hendricks further discloses the steps of "wherein said transmitting includes transmitting the targeted advertisements"; "wherein the targeted advertisements are selected for the subscribers based on subscriber characteristics"; "wherein the subscriber characteristics includes at least some subset of demographics attributes, geographic attributes, psychological attributes, and viewing attributes"; further comprising "forming subgroups of subscribers that share one or more

common subscriber characteristics, wherein said transmitting includes transmitting the advertisements to the subgroups"; and "selecting targeted advertisements for the subgroups wherein said transmitting includes transmitting the targeted advertisements to the subgroups", i.e., a polling cycle routine and alternative advertisement targeting routine are used for targeting groups or subgroups of subscribers for advertisements based on at least some subset of their demographics attributes, geographic attributes, psychological attributes, and viewing attributes (Figs. 25-34, col. 66/lines 37-51 for user profile used for targeting advertisements; and col. 68/line 61 to col. 69/line 60 for polling technique; and col. 69/line 61 to col. 74/line 67 for a variety of techniques in targeting advertisements to users using demographics and viewing habits).

As for claim 35, in further view of claim 32 above, Hendricks further discloses "wherein said transmitting includes transmitting the advertisement off-peak", i.e., ranking the programs based on different time slots during a given day, off peak time such as morning time slot (col. 75/lines 17-28 for ranking different viewing habits for different time slots during a day).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

7. Claims 23-26, 30-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (U.S. Patent 6,463,585 B1) in view of Schoenblum et al. (US Patent 6,418,122 B1/ or "Schoen" for short).

Regarding claims 23-26, 30-31 and 34, Hendricks does not disclose the step of "transmitting the advertisement channel at a constant bit rate, a variable bit rate that changes over time according to the amount of bandwidth available for the advertisement channel, wherein the bandwidth available for the advertisement channel is determined by subtracting amount of bandwidth used by the television network from total bandwidth of the television network, wherein the amount of bandwidth used by the television network includes bandwidth for transmitting programming channels"; however, Schoen teaches a same technique in utilize the bandwidth in receiving bit stream of data and dynamically prevents the bandwidth overflow in broadcasting programs and commercials to subscribers (col. 1/lines 20-62), i.e., transmitting the advertisement channel can be at a constant bit rate because the rate at which the receiving device such as a set top box receives images is constant and can be varied at a variable rate, and with the example therein, a sequence of images of a commercial is less number of bits, or less bandwidth, or lower bit rate than other programs and that commercial is only a part of broadcasting programs, which is also a substraction part of the total bandwidth transmitted (col. 1/line 63 to col. 2/line 10 & col. 2/line 63 to col. 3/line 23 & col. 5/lines 1-20 due to changing conditions concerned; and Fig. 3, col. 5/line 65 to col. 6/line 39 for a solution).

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' system with Schoen's teaching technique of assuring sufficient bandwidth in broadcasting data including commercials or advertisements as disclosed in order to maximize and utilize most of available bandwidth in broadcasting technique as avoiding bandwidth overflowing as suggested by Scheon.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Krista Bui
Art Unit 2611
October 21, 2003